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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,279	04/20/2004	Christopher B. Best	20003.0080	2647

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EXAMINER

PASSANITI, SEBASTIANO

ART UNIT PAPER NUMBER

3711

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/827,279

**Applicant(s)**

BEST, CHRISTOPHER B.

**Examiner**

Sebastiano Passaniti

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8,10-13,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10-13,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This Office action is responsive to communication received 10/12/2005 –  
Amendment.

The examiner in charge of this application has changed. Updated  
correspondence information may be found at the end of this Office action.

Claims 9 and 14-18 have been canceled, as directed.

Claims 1-8, 10-13, 19 and 20 remain pending.

Following is an action on the MERITS:

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that  
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-8, 10-13 and 19 are rejected under 35 U.S.C. 103(a) as being  
unpatentable over Rudell ('184). The patent to Rudell shows every feature claimed with  
the exception of the specific, claimed thickness of the dampening member. The

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claimed thickness of 0.02 inch to 1 inch (claim 1) and furthered with the claimed thickness of 0.03 inch to 0.08 inch (claim 10) is what would commonly be found if a moderate amount of adhesive or a regular and customary piece of commercially available double-sided tape were to be used between the rear of the striking face and a front portion of the main body. In other words, the skilled artisan would have found it obvious to select an appropriate amount of adhesive or use an adhesive material of sufficient thickness to provide adequate holding power between the striking face and the main body of the putter head. Note, the applicant has already disclosed that the dampening member may be a layer of adhesive. As to claim 2, Rudell notes that the body may comprise steel (col. 5, lines 49-62), while the striking plate, though preferably formed of wood, may utilize any material used for or the same as the main body, including aluminum (col. 4, lines 4-32). As to claim 4, although no specific mention is made as to the covering of all of the rear surface by the dampening member in Rudell, i.e., the adhesive between the striking plate and main body, it is clear that one of ordinary skill in the art would have found it almost common sense to cover the entire rear surface of the striking member with adhesive prior to attachment of the striking plate to the main body, simply for greater holding power. As to claim 5, Rudell indicates that any one of a number of common mechanical expedients such as screws, snap fittings or tongue and groove joints as well as adhesives and cements may be used throughout the assembly of the head (col. 4, lines 8-14). As to claims 6 and 7, the face member is substantially if not completely isolated from the main body by the dampening member (adhesive). As to claim 8, the dampening member has been indicated here as

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an adhesive. As to claims 11 and 12, note that the striking face in Rudell is disclosed as being from 0.1 cm to 0.3 cm thick (0.0394 inch to 0.1187 inch), thereby meeting the claimed requirements for thickness. As to claim 13, Rudell clearly shows a putter head. As to claim 19, it would appear that the skilled artisan would have obviously found it to be a matter of common sense to have provided a layer of uniformly thickened adhesive applied between the striking face and the main body. A non-uniform amount of adhesive might adversely affect the ball striking characteristics of the club head.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell in view of Morrison ('638). Rudell shows every feature claimed with the exception of a hosel to accept a shaft. Morrison show it to be old in the art to attach a shaft to the top of a putter head either directly or through the use of a hosel assembly (Figures 3 and 4 as well as col. 2, lines 37-45. In view of the patent to Morrison, it would have been obvious to modify the device in the cited art reference to Rudell by supplying a hosel into which the shaft is fitted and subsequently mated to the top of the club head main body, the motivation being to simply take advantage of another common joining technique for the shaft and the head.

Claims 1, 3, 4, 6, 8, 13, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Solheim ('518).

As to claim 1, note face member (32), body member (12) and dampening member (50). The dampening member (50) is in essence a piece of double-sided tape that is disclosed as being approximately 0.015 inch thick, which anticipates the claimed "approximately 0.02 inch" thickness.

As to claim 3, note hosel (14).

As to claim 4, see the embodiment in Figure 8. Note, the claim does not preclude the attachment of the dampening member to the face member in an indirect fashion.

As to claim 6, the face member remains substantially isolated from the body as shown in Figure 7.

As to claim 8, Solheim uses a double-sided tape which in essence is an adhesive, as detail, supra.

As to claim 13, Solheim clearly shows a putter.

As to claim 19, the dampening member, in this case a double-sided tape, is clearly shown as being of uniform thickness (Figure 7).

As to claim 20, the face (32) is partially in contact with the body (12) adjacent the top and bottom portions of the face member (Figure 9).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-8, 10-13, 19 and 20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp  
February 17, 2006

  
**Sebastiano Passaniti**  
Primary Examiner